

GAPUS1225



PATENT
P57672

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

YOUNG-TAEK SUL

Serial No.: 10/550,197

Examiner: WERNER, JONATHAN S.

Filed: 21 September 2005

Art Unit: 3732

For: HELICAL IMPLANT

RENEWED PETITION UNDER 37 CFR §1.181

Mail Stop: Petition

Office of Petitions

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In response to Decision on Petition mailed on 4 December 2007, entry and consideration of the following timely filed petition is respectfully requested. Applicant respectfully petitions from the Examiner's requirement in a final Office action (Paper No. 20070322) mailed on 10 April 2007 that Figure 6 be labeled as "Prior Art", and as reasons therefore, states that:

Folio: P57672

Date: 2/4/08

I.D.: REB/sb

STATEMENT OF FACTS

1. On 10 April 2007, the Examiner mailed a final Office action (Paper No. 20070322). Paper No. 20070322 mentioned the requirement of labeling Figure 6 as "Prior Art."

2. On the 14th of May 2007, Applicant filed a *Petition Under 37 CFR §1.181* to seek reversal and withdrawal of the Examiner's requirement that Figure 6 as "Prior Art."

3. In a *Decision On Petition* dated on the 4th of December 2007, the Group Director dismissed Applicant's *Petition Under 37 CFR §1.181*.

4. Seven (7) copies of Decisions on Petition for the following references previously issued by Group Directors are enclosed:

- Paper No. (unknown) issued on 23 October 2006 for U.S. Application Serial No. 10/374,980 filed on 3 March 2003;
- Paper No. (unknown) issued on 14 February 2005 for U.S. Application Serial No. 10/270,340 filed on 15 October 2002;
- Paper No. 9 issued on 16 October 2002 for U.S. Application Serial No. 10/057,956 filed on 29 January 2002;
- Paper No. 9 issued on 20 September 2002 for U.S. Application Serial No. 09/468,827 filed on 22 December 1999;
- Paper No. (unknown) issued on 15 December 1999 for U.S. Application Serial No. 08/985,544 filed on 5 December 1997;
- Paper No. 21 issued on 25 February 1998 for U.S. Application Serial No. 08/447,279 filed on 22 May 1995; and
- Paper No. 15 issued on 2 October 1996 for U.S. Application Serial No. 08/343,939 filed on 17 November 1994.

ARGUMENTS AND/OR REMARKS

In the Petition filed on the 14th of May 2007, Applicant explained that the record of the prosecution history for the above-captioned application showed that in the non-final Office action of the 4th of August 2006 and again in the final Office action of the 10th of April 2007, the examiner had objected to Figure 6 of Applicant's drawings, and had requested that Applicant designate by a legend such as "Prior Art" next to Fig 6. Applicant traversed that requirement because the Applicant believes that Figure 6 is not "Prior Art" as that term is statutorily defined under 35 U.S.C. §103(a) by reference to the several paragraphs of 35 U.S.C. §102, and presented four arguments demonstrating that the Examiner's objection was incorrect, and requested review of the examiner's objection to the drawings under MPEP 608.02(g).

In Paper No. 20070322, the Examiner objected to Figures 6-8 as not being labeled as "Prior Art" stating that "only that which is old is illustrated", and referring to MPEP §608.02(g), which states:

"Figures showing the prior art are usually unnecessary and should be cancelled, Ex parte Elliott, 1904 C.D. 103; 109 O.G. 1337. However, where needed to understand applicant's invention, they may be retained if designated by a legend such as "Prior Art."

If the prior art figure is not labeled, the following paragraph may be used.

Figures [1] should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 C.F.R. §1.121(d) are required in reply to the Office action to avoid abandonment of the application... The objection to the drawings will not be held in abeyance."

The prosecution history of this application demonstrates that Applicant has explained that Figure 6 is not "Prior Art"; consequently, MPEP §608.02(g) is inapplicable here. Moreover, whether Applicant intends to claim the subject matter of Figure 6, or whether Applicant is able to make a valid claim to the subject matter of Figure 6 are different issues which arise under 35 U.S.C. §§102 and 103(a), and which have not been raised during the prosecution history of this application.

First, in the *Decision On Petition*, the Group Director found, in essence that because (1) and unidentified "Webster dictionary" defined "conventional" as "lacking originality"; (2) by applying

the adjective “conventional” to Figures 6, 7 and 8, Applicant had made an “admission”, and by inference, that “admission” was legally equivalent to a declaration by Applicant that Figure 6 constituted “prior art” under 35 U.S.C. §102; and (3) by not including a discussion of Figures 7 and 8 under the subheading *Detailed Description of the Preferred Embodiments*, Figures 7 and 8 constituted “prior art.”

It should be noted that in this *Paper* Applicant petitions only from the requirement that Figure 6 be labeled as “prior art.”

In support of the decision to dismiss Applicant’s *Petition*, the Group Director wrote that:

“Under the heading of “Description of the Related Art” on pages 1-3 of the specification, the applicant explained Fig. 6 -8 as a conventional helical implant. The following relevant passages have been reproduced from page 2 of the specification.

“Fig. 6 is an enlarged view showing thread inclines of a conventional implant. Although various modifications in construction of the implant are well known in the art, a helical implant formed with threads 10b on the outer surface thereof is generally used in the art. As shown in the figure, according to the conventional helical implant, the threads 10b have thread inclines 10a, each having a fiat surface, to which surface preparation is not applied, and the thread inclines 10a of two adjacent threads 10b form an inclined angle of thread of approximately 60*.

Fig. 7 is a vertical sectional view of the conventional implant and Fig 8 is a traverse sectional view of the conventional implant showing and example of the conventional implant disclosed in EP 1992 0 850 168.”

“First, petitioner argues that the term “prior art” is defined by statute

not by the MPEP. Specifically, petitioner states nothing in any paragraph of § 102 sets forth that subject matter “which is old” constitutes prior art, as asserted by the Examiner. Petitioner also argues the age of the subject matter does not convert that subject matter into prior art, as the term “Prior Art” is defined by the law of the United States. Consequently, the Examiner’s sole rational for imposing the requirement that Figs. 6-8 be labeled as “Prior Art” is contrary to statute and improper.

In response to this first argument, according to the Webster dictionary, “conventional” means “lacking originality,” or put another way in accordance with U.S. patent intellectual property jargon, it is a reflection that whatever lacks originality is old. Thus, if applicant says something is “conventional”, this means it is old. The statement is an admission. As noted in the admitted prior art material in MPEP 2129,¹ admitted prior art may be used for purposes of anticipation and

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MPEP 2129 (1) Admissions as Prior Art I. ADMISSIONS BY APPLICANT CONSTITUTE PRIOR ART A statement by an applicant during prosecution identifying the work of another as “prior art” is an admission that that work is available as prior art against the claims, regardless of whether the admitted prior art would otherwise qualify as prior art under the statutory categories of 35 U.S.C. 102. *Riverwood Int ‘I Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 1354, 66 USPQ2d 1331, 1337 (Fed Cir. 2003). However, even if labeled as “prior art,” the work of the same inventive entity may not be considered prior art against the claims unless it falls under one of the statutory categories. *Id.*; see also *Reading & Bates Construction Co. v. Baker Energy Resources Corp.*, 748 F.2d 645, 650, 223 USPQ 1168, 1172 (Fed. Cir. 1984) (“[W]here the inventor continues to improve upon his own work product, his foundational work product should not, without a statutory basis, be treated as prior art solely because he admits knowledge of his own work. It is common sense that an inventor, regardless of an admission, has knowledge of his own work.”). Consequently, the examiner must determine whether the subject matter identified as “prior art” is applicant’s own work, or the work of another. In the absence of another credible explanation, examiners should treat such subject matter as the work of another.

obviousness regardless of whether the admitted prior art would otherwise qualify as prior art under the statutory categories of 35 U.S.C. §102. One may argue that Fig. 6 is not a printed publication, or known to others, etc. (i.e., does not fall into any of the paragraphs in 35 U.S.C. 102), but the Examiner may still use it to make a rejection if applicant has stated that the referenced admission is old, i.e., “conventional”. Under the MPEP 2129 and applicable case law, the Examiner has treated Fig. 6 as the work of another and is treatable as prior art to applicant as well. Therefore, Fig. 6 is considered to be “Prior Art”. Petitioner, it is noted, did not dispute this presumption that Fig. 6 is the work of another.

With regard to Figs. 7 and 8, based on the above passage from page 2 of the specification, the applicant references a 1992 disclosure therein and surely that is prior art in accordance with MPEP 2129 II.² No discussion of these drawings is further provided under the detailed description of the preferred embodiments. Therefore, Figs. 7 and 8 are considered to be “Prior Art” because undoubtedly EP 1992 0850 168 is a publication and is a form of “Prior Art”. Also, the claims as originally filed define “A helical implant formed with threads thereon...”. Figs 7 - 8 do illustrate the same conventional helical implant which formed with threads thereon that are the preamble for the claims. This illustrates that the applicant designated

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MPEP 2129 II. DISCUSSION OF PRIOR ART IN SPECIFICATION
Where the specification identifies work done by another as “prior art,” the subject matter so identified is treated as admitted prior art. In re Nomiya, 509 F.2d 566, 571, 184 USPQ 607, 611 (CCPA 1975) (holding applicant’s labeling of two figures in the application drawings as “prior art” to be an admission that what was pictured was prior art relative to applicant’s improvement).

“conventional implants” as an admission of prior art in accordance with MPEP 2129 III.³ Therefore, Figs. 7 and 8 are considered to be implied “Prior Art” as a matter of law. In the case Sjolund v. Musland, 6 USPQ2d 2020 (Fed. Cir. 1988), the Court held “It was uncontroverted that many relevant devices were old and the jury must have accepted their status as prior art. The first of these devices is the conventional king crab trap. The description of the prior art in the ‘071 patent states that “[c]onventional crab traps have been used in their present form for many years.” This same trap is defined in the preamble of claim 1, which is a Jepson claim. Since the preamble of a Jepson claim is impliedly admitted to be prior art, see Pentec, Inc. v. Graphic Controls Corp., 776 F.2d 309, 315, 227 USPQ 766,770 (Fed. Cir. 1985); Reading & Bates Construction Co. v. Baker Energy Resources Corp., 748 F.2d 645, 649-50, 223 USPQ 1168, 1172 (Fed. Cir. 1984); In re Ehrreich, 590 F.2d 902, 909-910, 200 USPQ 504, 510 (CCPA 1979), and the specification confirms this implied admission, the jury must have accepted the conventional trap as prior

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MPEP 2129 III. JEPSON CLAIMS Drafting a claim in Jepson format (i.e., the format described in 37 CFR 1.75(e); see MPEP § 608.01(m)) is taken as an implied admission that the subject matter of the preamble is the prior art work of another. In re Fout, 675 F.2d 297,301,213 USPQ 532, 534 (CCPA 1982) (holding preamble of Jepsontype claim to be admitted prior art where applicant’s specification credited another as the inventor of the subject matter of the preamble). However, this implication may be overcome where applicant gives another credible reason for drafting the claim in Jepson format. In re Ehrreich, 590 F.2d 902,909-910,200 USPQ 504,510 (CCPA 1979) (holding preamble not to be admitted prior art where applicant explained that the Jepson format was used to avoid a double patenting rejection in a co-pending application and the examiner cited no art showing the subject matter of the preamble). Moreover, where the preamble of a Jepson claim describes applicant’s own work, such may not be used against the claims. Reading & Bates Construction Co. v. Baker Energy Resources Corp., 748 F.2d 645, 650, 223 USPQ 1168, 1172 (Fed. Cir. 1984); Ehrreich, 590 F.2d at 909-910, 200 USPQ at 510.

art, as a matter of law. Here, this applicant clearly admits, under the heading “description of related art” (page 2 of the specification), Figs. 6-8 illustrate a conventional helical implant and defined in the preamble of the original claim 1. In view of the totality of the original specification and original claims, Figs. 6-8 constitute “Prior Art”.

Second, petitioner argues that Figures 6-8 are not themselves believed to constitute “Prior Art” as that term is defined by either 35 U.S.C. § 102 or 35 U.S.C. § 103. The Examiner has introduced no evidence into the record of this application which would either contradict the applicant’s belief or establish that Figures 6-8 constitute prior art, as that term is defined by 35 U.S.C. §103(a) of the statute, by its reference to §102 of the statute. The argument is not persuasive. Nowhere in the specification does the applicant disclose the origin of the subject matter of Fig. 6. In absence of another credible explanation by the applicant, the examiners treated the subject matter of Fig. 6 as the work of another. Therefore, Fig. 6 is deemed to be “Prior Art”. With regard to Figs. 7 and 8, based on the above passage from page 2 of the specification, the applicant references a 1992 disclosure EP 1992 08501 68 which is prior art in accordance with MPEP 2129 II and as discussed above. Therefore, Figs. 7 and 8 are considered to be “prior art”.

Third, petitioner argues that Figures 6-8 are simply abstract representations of the art prepared by the applicant in an effort to illustrate applicant’s discovery of problems plagued in the art in accordance with 37 C.F.R. § 1.83(b); this discovery is itself, together with Applicant’s abstraction of the art represented by Figures 6-8, part of the applicant’s invention. By identifying deficiencies in the prior art and then addressing those deficiencies, applicant completes the inventive process. As such, applicant’s effort to identify

deficiencies or other undesirable features in the art, does not constitute “Prior Art” as that term is defined under 35 USC §103, and 35 USC §§ 102(a)-(g). This line of argument is not convincing. Again, nowhere in the specification does the applicant mention the subject matter of Fig. 6 is the applicant’s own old machine which the disclosed and claimed improvement is based on in accordance with 37 CFR 1.183 (b).⁴ With regard to Figs. 7 and 8, repeating again, the applicant makes reference to a 1992 disclosure EP 1992 0850168 on page 2 of the specification, the 1992 disclosure EP 1992 0850168 clearly is considered to be prior art treatable under 35 USC §103 and 35 USC §102.

Fourth, petitioner argues that the applicant has never made any statement which could be construed as a declaration against interest or an admission that Figures 6-8 were “Prior Art”. Petitioner also argues that the applicant devised the subject matter of Figs. 6-8. The evidence lies in the fact that the only existence of Figures 6-8 are in the present application and it’s parent priority document Korean Application Serial No. 10-2003-0018745 filed on Mar. 26, 2003 and International Application No. PCT/KR04/000519 filed on Mar. 12, 2004. It is noted that nowhere in the specification does the applicant mention the subject matter of Figs. 6-8 was devised by the applicant. In the absence of another credible explanation in the specification, the examiner has treated Figs. 6-8 as the work of another. Not only is this proper, but the examiner would be remiss if he hadn’t. If

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37 CFR § 1.83 Content of drawing. (b) When the invention consists of an improvement on an old machine the drawing must when possible exhibit, in one or more views, the improved portion itself, disconnected from the old structure, and also in another view, so much only of the old structure as will suffice to show the connection of the invention therewith.

applicant is attributing the work to himself, attention is directed to affidavit practice under 37 CFR § 1.132 and MPEP 716.10.

Petitioner has exemplified other applications where decisions on petition have granted similarly raised objections as in the present application. Decisions on petition under 37 CFR §1.181 are not precedential and are each decided on their own merit. See *In re The Boulevard Entertainment, Inc.*, 334 F.3d 1336, 1343; 67 USPQ2d 1475, 1480 (Fed. Cir. 2003).

Applicant submits that regardless of the existence of an unidentified “Webster dictionary” defining “conventional” as “lacking originality”, nothing in either 35 U.S.C. §100 or in §102 sets a single requirement for labeling of drawings submitted in compliance with 37 CFR §1.83. Moreover, 35 U.S.C. §102 does not, without more, convert art which was “conventional” at the time when the an applicant made his invention, into “prior art”, either by finding an “admission” or by operation of law. Furthermore, the location where an applicant chooses to discuss Figure 6 does not constituted an assertion by that applicant that Figure 6 constitutes “prior art” under 35 U.S.C. §102. Applicant further submits that by not including a discussion of Figures 7 and 8 under the subheading *Detailed Description of the Preferred Embodiments*, Figure 6 is not converted into “prior art.”

Second, in Paper No. 20070322, the Office action dated 10 April 2007, the Examiner asserted that “Figures 6-8 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated” and cited §608.02(g) of the *Manual Patent Examining Procedure* (MPEP). Applicant submits that the term “Prior Art” is defined by statute, not by the MPEP. Specifically, 35 U.S.C. §103(a) and (b) define the term “Prior Art” by reference to the several paragraphs of 35 U.S.C. §102. Nothing in any paragraph of §102, however, states that subject matter “which is *old*” constitutes prior art, as asserted by the Examiner in page 2 of the Office action, Paper No. 20070322. In short, the age of the subject matter does not convert that subject matter into prior art, as the term “prior art” is defined by the law of the United States. Consequently, the Examiner’s sole rational for imposing the requirement that Figure 6 be labeled as “Prior Art” is contrary to statute and improper. The requirement must be therefore be withdrawn.

Third, Figure 6 is not itself believed to constitute “Prior Art” as that term is defined by either 35 U.S.C. §102 or 35 U.S.C. §103. The Examiner has introduced no evidence into the record of this application which would either contradict Applicant’s belief or establish that Figure 6 constituted *prior art*, as that term is defined by 35 U.S.C. §103(a) of the statute, by its reference to §102 of the statute. As evidenced from the Declaration/Oath, the Applicant is a citizen of Republic of Korea, and, as such, devised Figure 6 in Korea in order to illustrate Applicant’s discovery of problems that Applicant had discovery to have plagued the art. Therefore, since there is no showing that Figure 6 were known to anyone other than the Applicant *in this country* nor is there a showing that Figure 6 were *patented or published in this country or a foreign country* except when published, or laid-open, in Applicant’s Korean priority application Serial No. 10-2003-0018745 filed on 26 March 2003, then Figure 6 can not be deemed to be “Prior Art” absent evidence to the contrary.

Fourth, Figure 6 is simply abstract representations of the art prepared by the Applicant in an effort to illustrate Applicant’s discovery of problems plagued in the art in accordance with 37 C.F.R. §1.83(b); this discovery is itself, together with Applicant’s abstraction of the art represented by Figure 6, part of the Applicant’s invention. By identifying deficiencies in the prior art and then addressing those deficiencies, Applicant completes the inventive process. As such, Applicant’s effort to identify deficiencies or other undesirable features in the art, does not constitute “Prior Art” as that term is used under 35 USC §103, and defined by 35 USC §§102(a)-(g).

Fifth, Applicant has never made any statement which could be construed as a declaration against interest or an admission that Figure 6 was “Prior Art”. If the Examiner is relying on the Applicant’s use of the word “conventional” to mean “known by others in this country”, then the Examiner is incorrect. The present application is based on, and is a translation of, Korean Application Serial No. 10-2003-0018745, on which the Applicant has claimed priority as evidenced by the Declaration (Oath). Accordingly, the term “conventional” can, at most, only be considered with respect to Korea, not this country. MPEP §706.02(c) states, in part:

“The language “in this country” means in the United States only and does not include other WTO or NAFTA member countries.”

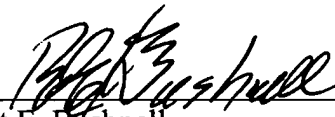
If the Examiner is relying on the Applicant's use of the word “conventional” to mean “patented or published in this country or a foreign country”, then the Examiner is again incorrect. There is no evidence that Figure 6 exists in any printed form other than in the present application and its priority document. There is evidence to indicate that Applicant devised the subject matter in Figure 6 however, and that evidence lies in the fact that the only existence of Figure 6 are in the present application and its parent priority document Korean Application Serial No. 10-2003-0018745 filed on 26 March 2003 and International Application No. PCT/KR04/000519 filed on the 12th of March 2004.

REMEDY REQUESTED

The Commissioner is respectfully requested to:

- A. Withdraw the requirement for Applicant to label Figure 6 as "Prior Art";
- B. Return the prosecution history to the Examiner to reprove any assertion that Figure 6 should be identified as "Prior Art"; and
- C. Grant Applicant such other and further relief as justice may require.

Respectfully submitted,



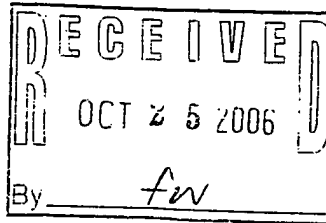
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Decision on
Petition.

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P56862
(YFM)

In re application of
Jung-Il Nam et al.

Serial No. 10/374,980

Filed: March 3, 2003

For: SECONDARY BATTERY WITH ENHANCED ABILITY TO PREVENT LEAKAGE

DECISION ON
PETITION

This is a decision on the PETITION UNDER 37 CFR 1.181, filed September 26, 2006, requesting that the requirement to label Figures 5 and 6 as "Prior Art" be withdrawn.

On September 18, 2006, an office action was mailed by the examiner containing a requirement to label Figures 5 and 6, as Prior Art, since only that which is old is illustrated.

A review of the application indicates that the subject matter in Figures 5 and 6 illustrates a secondary battery and a cap for the battery. However, there is no indication in the disclosure that the subject matter depicted in Figures 5 and 6 is expressly considered by the Applicant to be "Prior Art".

The petition is **GRANTED**.

Accordingly, the requirement that Figures 5 and 6 be labeled as "Prior Art" is withdrawn. It is noted that Applicant's time for response to the September 18, 2006 office action continues to run as set forth in the office action.

Jacqueline M. Stone, Director
Technology Center 1700
Chemical and Materials Engineering

Robert E. Bushnell
1522 "K" Street N.W., Suite 300
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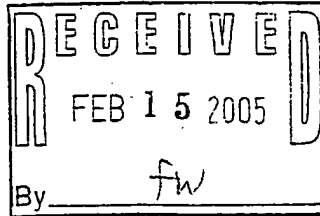


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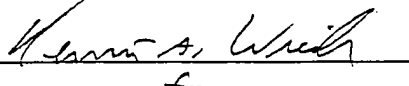
In re Application of:
Kyung-Hwa Min
Application Serial No.: 10/270,340
Filed: October 15, 2002
For: **METHOD FOR TESTING SUBSCRIBER
LINE OF PRIVATE AUTOMATIC BRANCH
EXCHANGE USING DUAL-TONE MULTI-
FREQUENCY SIGNAL**

DECISION
ON PETITION

This is a decision on the petition, under 37 C.F.R. §1.181, filed on December 2, 2004 requesting the withdrawal of the requirement to label Figure 1 as "Prior Art".

The petition is GRANTED.

A review of the record indicates that Figure 1 as originally filed and discussed was referred to as containing a "conventional" line tester in a subscriber circuit. The original disclosure did not indicate that the figure was prior art. Hence, in keeping with the disclosure and applicant's arguments, the requirement to label this figure as "Prior Art" is withdrawn.


for

Mark R. Powell
Technology Center 2600
Communications



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Paper No. 9

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OCT 18 2002

OCT 16 2002

In re Application of
Chang-Hum Lee
Application No. 10/057,956
Filed: January 29, 2002
For: DEVICE AND METHOD FOR DISPLAYING
CHARGE CAPACITY INFORMATION OF SMART
BATTERY

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.181, filed on August 22, 2002, requesting that the requirement to label Figures 1 and 2 as "Prior Art" be withdrawn.

The petition is GRANTED.

A review of the application indicates that the subject matter of Figures 1 and 2 illustrates a process for displaying residual capacity information of a general smart battery. However, there is no indication in the disclosure that the subject matter depicted in Figures 1 and 2 is expressly considered by the Applicant to be "Prior Art."

Accordingly, the requirement that Figures 1 and 2 be labeled "Prior Art" is withdrawn.

The application file is being forwarded to Publications for further processing.

Richard Seidel, Director
Technology Center 2800
Power Generation and Distribution, Music,
Electrical Components and Control Circuits



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DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of:
HYUNG-GON LEE
Application No. 09/468,827
Filed: December 22, 1999
For: VOICE CODING CONVERSION
CIRCUIT BETWEEN OFFICE EXCHANGE
AND ISDN KEYPHONE SYSTEM

DECISION ON PETITION

COPY

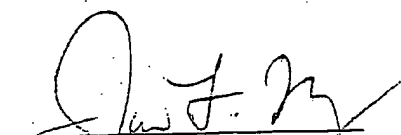
This is a decision on the petition filed June 11, 2002 under 37 CFR 1.181 of the requirement of the Examiner to label Applicant's Figure 1 as "prior art".

On June 3, 2002, a non-final Office action was issued requiring Figure 1 of the drawings to be labeled as "prior art".

A review of the application disclosure shows that applicant describes the subject matter of Figure 1 in conventional terms. There is no indication in the disclosure that the subject matter of the figure is expressly considered by the application to be "prior art". Therefore, the Examiner's requirement that Figure 1 should be labeled as "prior art" is incorrect and will be withdrawn in the next Office Action.

Accordingly, the petition is **GRANTED**.

The application file will be forwarded to the Examiner to await a response from the applicant on the remaining outstanding issues as set forth in the Office Action mailed on June 3, 2002.


Jin F. Ng, Director
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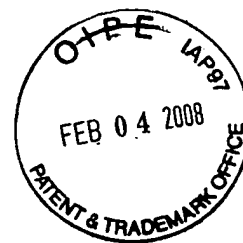
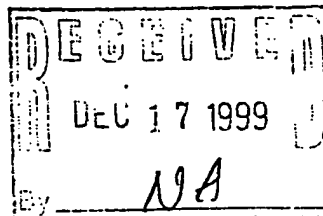
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DEC 15 1999

Office of the Director
Group 3600



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Patent and Trademark Office
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Washington, D.C. 20231



ROBERT E BUSHNELL
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In re application of
Hae-Won Ahn
Serial No.: 08/985,544
Filed : December 5, 1997
For: FRONT CASE STRUCTURE OF CRT
DISPLAY DEVICE

PS4947

: DECISION ON PETITION
: UNDER 37 CFR §1.181
: REQUESTING THAT
: THE COMMISSIONER
: INVOKE SUPERVISORY
: AUTHORITY

In the renewed petition filed September 9, 1999, applicant requested that the Commissioner invoke supervisory authority by instructing the examiner to withdraw the requirement that Figs. 1 and 2 be labeled as "Prior Art". The petition is GRANTED.

This petition presents two issues. First, are the figures in question necessary to the understanding of the invention? A review of the application has been made and it is considered that the figures are necessary to the understanding of the invention. Second, are the figures required to be labeled with the legend "Prior Art"?

A careful review of the application papers indicates that the subject matter of Figures 1 and 2 are considered by applicant to be "conventional". However, there is no indication in the disclosure that the subject matter of the figures is expressly considered by the applicant to be "Prior Art". If applicant states that something is prior art, it is available for use against the claims. See In re Nomiya, 184 USPQ 607 (CCPA 1975), MPEP §2129. No opinion is expressed in this decision whether the subject matter of Figures 1 and 2 are "Prior Art" since this is an appealable issue, MPEP §1201.

Finally, any concerns raised in the previous decision regarding applicant's duty of disclosure are withdrawn. The Office does not normally investigate such issues.
1135 Off. Gaz. Pat. Office, 13 (Jan. 9, 1992).

This application is being forwarded to the examiner for reinstatement of Figs. 1 and 2 and deletion of the amendment after final filed August 4, 1999.

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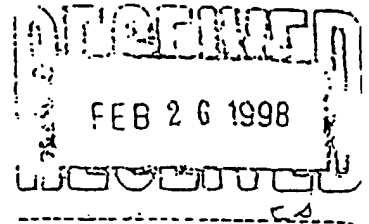
Director's Office
Group 2700



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
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Washington, D.C. 20231

Paper No. 21

Robert E. Bushnell
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In re Application of)
Gwon-Il Kim)
Application Serial No.)
08/447,279)
Filed: May 22, 1995)
For: SERVO CONTROLLER)
APPARATUS AND METHOD)
OF DISK RECORDING)
SYSTEM)

DECISION ON RENEWED
PETITION UNDER
37 C.F.R. § 1.181

This is a decision on the renewed petition filed August 25, 1997 under 37 C.F.R. § 1.181 of the repeated requirement of the Examiner to label Applicant's Figures one through three as "prior art". The petition is treated as a request for reconsideration of the previous decision of August 19, 1997 in which the requirement of labeling figures one through three as "prior art" was maintained.

A careful review of the application papers indicates that the subject matter of figures one through three is considered by applicant to be "conventional". However, there is no indication in the disclosure that the subject matter of the figures is expressly considered by the applicant to be "prior art". "When applicant states that something is prior art, it is taken as being available as prior art against the claims. Admitted prior art can be used in obviousness rejections. In re Nomiya, 184 USPQ 607, 610 (CCPA 1975) (Figures in the application labeled "prior art" held to be an admission that what was pictured was prior art relative to applicant's invention.)" See M.P.E.P. § 2129. The decision, supra, was cited by both petitioner and the deciding official in the previous petition. Whether the subject matter of figures one through three of the instant application is prior art against the claims is an appealable determination and, accordingly, will not be entertained in this decision, see M.P.E.P. § 1201.

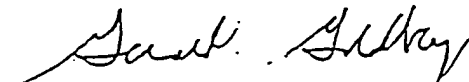
There is no requirement that a particular figure or figures be labeled as "prior art". The MPEP at section 608.02(g) indicates that if prior art figures are to be retained in the file they

should be designated with the legend of "prior art". No requirement is made for an applicant to label figure(s) as "prior art" where there is no such indication in the disclosure.

Consequently, the requirement that figures one through three each be designated by the legend of "prior art" is withdrawn.

As the time for perfecting the appeal under 37 C.F.R. § 1.192(a) has expired without the submission of an Appeal Brief, the appeal is hereby dismissed, 37 C.F.R. § 1.192(b). The application file will be forwarded to the examiner for appropriate action in due course.

SUMMARY: Petition GRANTED.

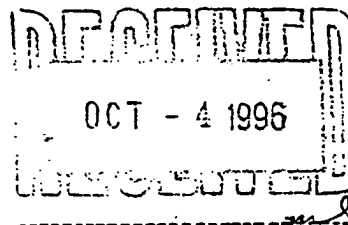


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T 53716



UNITED STATES DEPARTMENT OF COMMERCE
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Washington, D.C. 20231



In re Application of
MYUNG-CHAN JEONG
Serial No: 08/343,939
Filed on : November 17, 1994
For : DIGITAL SERVO CONTROL
APPARATUS AND METHOD
OF DATA STORAGE SYSTEM
USING DISK RECORDING
MEDIA

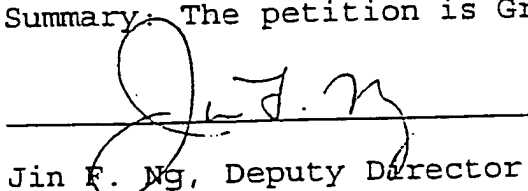
DECISION ON PETITION
UNDER 37 CFR 1.181

This is a decision on the petition filed on September 13, 1996
requesting the withdrawal of the requirement to label Fig. 3 as
"Prior Art".

The petition is GRANTED..

A review of the record indicates that figure 3 as originally
filed and discussed was referred to as "CONVENTIONAL". Hence, in
keeping with the disclosure and petitioner's arguments, the
examiners' requirement to label this figure as "Prior Art" is
incorrect and withdrawn.

Summary: The petition is Granted.


Jin F. Ng, Deputy Director
Examining Group 2500
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and Devices

JFN/AMP

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GROUP 2500